



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,612	01/16/2001	Scott Howard Prager	3330/51	4895

29858 7590 04/19/2005

BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP
900 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER

DUONG, THOMAS

ART UNIT	PAPER NUMBER
----------	--------------

2145

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/760,612

Applicant(s)

PRAGER, SCOTT HOWARD

Examiner

Thomas Duong

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

h

DETAILED ACTION

Response to Amendment

1. This office action is in response to the applicants Amendment filed on December 10, 2004. Applicant amended *claims 1, 9, 10, 13, and 19*. *Claims 1-19* are presented for further consideration and examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. *Claims 1-5 and 9-19* are rejected under 35 U.S.C. 102(e) as being anticipated by Arnold et al. (US006167449A).

4. With regard to *claims 1, 9-10, 13 and 19*, Arnold discloses,

- *capturing at the first system a search (queries) for invocable logic units (registered services) issued from the second system (application 110, interface 120); (Arnold, col.3, lines 29-34, lines 55-58; col.4, lines 10-16)*

Arnold teaches of a client computer or machine querying the servers for externally accessible registered services. *"In particular, the interface looks up*

the type of service in each SIP [(service identification protocol)] server's database of registered services" (Arnold, col.3, lines 56-58) following *"a client application ('application') in the AppleTalk network sending a look-up request to an interface for a particular type of service"* (Arnold, col3, lines 29-34). In addition, it can be inferred from Arnold that the *"[collected] entries in the SIP server database that have fields matching the requested service type"* (Arnold, col.4, lines 10-11) are returned to the interface, which, in turns, *"returns the result data (including perhaps the service name and/or the network address of a provider of the requested type of service) to the application"* (Arnold, col.4, lines 11-14).

- *returning a list of one or more externally invocable logic units of the first system as a result for the captured search;* (Arnold, col.4, lines 10-16)

Arnold teaches of a client computer receiving the result from querying the servers for externally accessible registered services. In particular, it can be inferred from Arnold that the *"[collected] entries in the SIP server database that have fields matching the requested service type"* (Arnold, col.4, lines 10-11) are returned to the interface, which, in turns, *"returns the result data (including perhaps the service name and/or the network address of a provider of the requested type of service) to the application"* (Arnold, col.4, lines 11-14).

- *capturing at the first system a command to invoke a logic unit issued from the second system; and* (Arnold, col.3, line 62 – col.4, line 9; col.4, lines 22-25)

Arnold teaches that *"after the interface has provided the application with, for instance, a Uniform Resource Location (URL) of a provider of the requested type of service, the application can cause a more specialized application (such as a*

Web browser) to be launched which can then use the URL to easily access the provider's services" (Arnold, col4, lines 19-25). In other words, a command is issued from the second system via an application in order to access or invoke a type of service at the first system. In addition, if the requested service, issued from the second system, was the FTP or SMTP service, and, if available, the second system would possibly invoke these services by issuing the appropriate commands to the first system.

- *if the logic unit identified in the captured command is a listed logic unit, causing the first system to invoke the identified logic unit, receiving the results of the invocation of the identified logic unit from the first system, and returning the results to the second system. (Arnold, col.3, line 62 – col.4, line 9; col.4, lines 22-25)*

Arnold teaches that *"after the interface has provided the application with, for instance, a Uniform Resource Location (URL) of a provider of the requested type of service, the application can cause a more specialized application (such as a Web browser) to be launched which can then use the URL to easily access the provider's services" (Arnold, col4, lines 19-25). In other words, a command is issued from the second system via an application in order to access or invoke a type of service at the first system. In addition, if the requested service, issued from the second system, was the FTP or SMTP service, and, if available, the second system would possibly invoke these services by issuing the appropriate commands to the first system.*

5. With regard to claims 2, 11-12 and 17-18, Arnold discloses,

Art Unit: 2145

- *wherein the list identifies the externally invocable logic units of the first system that match a search pattern. (Arnold, col.4, lines 10-16; col.7, lines 7-11)*

Arnold teaches of a client computer receiving the result from querying the servers for externally accessible registered services.

6. With regard to claims 3-5 and 14-16, Arnold discloses,

- *wherein causing the first system to invoke the identified logic unit comprises:*
 - *extracting data associated with the identified logic unit from the second system; providing the extracted data to the first system; and instructing the first system to invoke the identified logic unit. (Arnold, col.12, lines 31-35)*

Arnold teaches of converting the resulted data from one format into another format.

- *wherein providing the extracted data comprises:*
 - *converting the extracted data from a format associated with the second system to a format associated with the first system; and passing the converted data to the first system. (Arnold, col.12, lines 31-35)*

Arnold teaches of converting the resulted data from one format into another format.

7. Claims 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Arnold et al. (US006167449A).

8. With regard to claims 6-8, Arnold discloses,

- *capturing, at the third system (network of servers 122), a search (queries) for invocable logic units (registered services) issued from the second system (NSL Manager 114 and plug-ins 118); (Arnold, col.3, lines 55-58; col.5, lines 12-60; fig.2)*

Arnold teaches of an application, which may runs from a client computer, querying the NSL Manager, which may run on a separate machine suggested by the dashed box, for externally accessible registered services from the network servers. The dashed box in figure 2 suggests that the interface between the application and the servers is capable of existing by itself as a separate entity. In addition, Arnold does not require that the interface and the application exist on the same machine, hence leaving to interpretation of the possibility of the interface existing on its own on another machine.

- *returning, from the third system to the second system, a list of one or more externally invocable logic units of the first system as a result for the captured search; (Arnold, col.4, lines 10-16; col.5, lines 12-60; fig.2)*

Arnold teaches of a client computer receiving the result from querying the servers for externally accessible registered services. In particular, it can be inferred from Arnold that the “[collected] entries in the SIP server database that have fields matching the requested service type” (Arnold, col.4, lines 10-11) are returned to the interface, which, in turns, “returns the result data (including perhaps the service name and/or the network address of a provider of the requested type of service) to the application” (Arnold, col.4, lines 11-14).

Art Unit: 2145

- *capturing, at the third system, a command to invoke a logic unit issued from the second system; and (Arnold, col.3, line 62 – col.4, line 9; col.4, lines 22-25; col.5, lines 12-60; fig.2)*

Arnold teaches that *"after the interface has provided the application with, for instance, a Uniform Resource Location (URL) of a provider of the requested type of service, the application can cause a more specialized application (such as a Web browser) to be launched which can then use the URL to easily access the provider's services"* (Arnold, col4, lines 19-25). In other words, a command is issued from the second system via an application in order to access or invoke a type of service at the first system. In addition, if the requested service, issued from the second system, was the FTP or SMTP service, and, if available, the second system would possibly invoke these services by issuing the appropriate commands to the first system.

- *if the logic unit identified in the captured command is a listed logic unit, causing, from the third system, the first system to invoke the identified logic unit, receiving, at the third system, the results of the invocation of the identified logic unit from the first system, and returning the results to the second system from the third system. (Arnold, col.3, line 62 – col.4, line 9; col.4, lines 22-25; col.5, lines 12-60; fig.2)*

Arnold teaches that *"after the interface has provided the application with, for instance, a Uniform Resource Location (URL) of a provider of the requested type of service, the application can cause a more specialized application (such as a Web browser) to be launched which can then use the URL to easily access the provider's services"* (Arnold, col4, lines 19-25). In other words, a command is

issued from the second system via an application in order to access or invoke a type of service at the first system. In addition, if the requested service, issued from the second system, was the FTP or SMTP service, and, if available, the second system would possibly invoke these services by issuing the appropriate commands to the first system.

Response to Arguments

9. Applicant's arguments with respect to *claims 1, 9, 10, 13, and 19* have been considered but they are not persuasive.

10. With regard to *claims 1, 9, 10, 13 and 19*, the Applicants point out that:

- *Arnold fails to teach or suggest the elements of claim 1 of the present invention. First, Arnold does not teach or suggest capturing a search for invocable logic units.*
- *Arnold also fails to discuss the claimed element of returning a list of one or more externally invocable logic units of the first system as a result for the captured search.*
- *The Examiner is also mistaken that Arnold shows the element, as amended, of capturing at the first system a command to invoke a logic unit issued from the second system.*
- *Similarly, Arnold fails to discuss causing the first system to invoke the identified logic unit.*

However, the Examiner finds that the Applicants' arguments are not persuasive and maintains that Arnold discloses,

Art Unit: 2145

- *capturing at the first system a search (queries) for invocable logic units (registered services) issued from the second system (application 110, interface 120); (Arnold, col.3, lines 29-34, lines 55-58; col.4, lines 10-16)*

Arnold teaches of a client computer or machine querying the servers for externally accessible registered services. *"In particular, the interface looks up the type of service in each SIP [(service identification protocol)] server's database of registered services"* (Arnold, col.3, lines 56-58) following *"a client application ('application') in the AppleTalk network sending a look-up request to an interface for a particular type of service"* (Arnold, col3, lines 29-34). In addition, it can be inferred from Arnold that the *"[collected] entries in the SIP server database that have fields matching the requested service type"* (Arnold, col.4, lines 10-11) are returned to the interface, which, in turns, *"returns the result data (including perhaps the service name and/or the network address of a provider of the requested type of service) to the application"* (Arnold, col.4, lines 11-14).

- *returning a list of one or more externally invocable logic units of the first system as a result for the captured search; (Arnold, col.4, lines 10-16)*

Arnold teaches of a client computer receiving the result from querying the servers for externally accessible registered services. In particular, it can be inferred from Arnold that the *"[collected] entries in the SIP server database that have fields matching the requested service type"* (Arnold, col.4, lines 10-11) are returned to the interface, which, in turns, *"returns the result data (including perhaps the service name and/or the network address of a provider of the requested type of service) to the application"* (Arnold, col.4, lines 11-14).

- *capturing at the first system a command to invoke a logic unit issued from the second system; and (Arnold, col.3, line 62 – col.4, line 9; col.4, lines 22-25)*
Arnold teaches that “after the interface has provided the application with, for instance, a Uniform Resource Location (URL) of a provider of the requested type of service, the application can cause a more specialized application (such as a Web browser) to be launched which can then use the URL to easily access the provider’s services” (Arnold, col4, lines 19-25). In other words, a command is issued from the second system via an application in order to access or invoke a type of service at the first system. In addition, if the requested service, issued from the second system, was the FTP or SMTP service, and, if available, the second system would possibly invoke these services by issuing the appropriate commands to the first system.
- *if the logic unit identified in the captured command is a listed logic unit, causing the first system to invoke the identified logic unit, receiving the results of the invocation of the identified logic unit from the first system, and returning the results to the second system. (Arnold, col.3, line 62 – col.4, line 9; col.4, lines 22-25)*

Arnold teaches that “after the interface has provided the application with, for instance, a Uniform Resource Location (URL) of a provider of the requested type of service, the application can cause a more specialized application (such as a Web browser) to be launched which can then use the URL to easily access the provider’s services” (Arnold, col4, lines 19-25). In other words, a command is issued from the second system via an application in order to access or invoke a type of service at the first system. In addition, if the requested service, issued

from the second system, was the FTP or SMTP service, and, if available, the second system would possibly invoke these services by issuing the appropriate commands to the first system.

Therefore, the Applicants still failed to clearly disclose the novelty of the invention and identify specific limitation, which would define patentable distinction over prior art.

11. With regard to claim 6, the Applicants point out that:

- *Independent claim 6 is also distinguishable over Arnold for substantially similar reasons as presented in connection with independent claim 1. Furthermore, applicant respectfully disagrees with the Examiner's characterization of the NSL manager of Fig. 2 running on a separate machine as suggested by the dashed box.*

However, the Examiner finds that the Applicants' arguments are not persuasive and maintains that Arnold discloses,

- *capturing, at the third system (network of servers 122), a search (queries) for invocable logic units (registered services) issued from the second system (NSL Manager 114 and plug-ins 118); (Arnold, col.3, lines 55-58; col.5, lines 12-60; fig.2)*

Arnold teaches of an application, which may runs from a client computer, querying the NSL Manager, which may run on a separate machine suggested by the dashed box, for externally accessible registered services from the network servers. The dashed box in figure 2 suggests that the interface between the application and the servers is capable of existing by itself as a separate entity. In

addition, Arnold does not require that the interface and the application exist on the same machine, hence leaving to interpretation of the possibility of the interface existing on its own on another machine.

- *returning, from the third system to the second system, a list of one or more externally invocable logic units of the first system as a result for the captured search;* (Arnold, col.4, lines 10-16; col.5, lines 12-60; fig.2)

Arnold teaches of a client computer receiving the result from querying the servers for externally accessible registered services. In particular, it can be inferred from Arnold that the “[collected] entries in the SIP server database that have fields matching the requested service type” (Arnold, col.4, lines 10-11) are returned to the interface, which, in turns, “returns the result data (including perhaps the service name and/or the network address of a provider of the requested type of service) to the application” (Arnold, col.4, lines 11-14).

- *capturing, at the third system, a command to invoke a logic unit issued from the second system; and* (Arnold, col.3, line 62 – col.4, line 9; col.4, lines 22-25; col.5, lines 12-60; fig.2)

Arnold teaches that “after the interface has provided the application with, for instance, a Uniform Resource Location (URL) of a provider of the requested type of service, the application can cause a more specialized application (such as a Web browser) to be launched which can then use the URL to easily access the provider’s services” (Arnold, col4, lines 19-25). In other words, a command is issued from the second system via an application in order to access or invoke a type of service at the first system. In addition, if the requested service, issued from the second system, was the FTP or SMTP service, and, if available, the

Art Unit: 2145

second system would possibly invoke these services by issuing the appropriate commands to the first system.

- *if the logic unit identified in the captured command is a listed logic unit, causing, from the third system, the first system to invoke the identified logic unit, receiving, at the third system, the results of the invocation of the identified logic unit from the first system, and returning the results to the second system from the third system. (Arnold, col.3, line 62 – col.4, line 9; col.4, lines 22-25; col.5, lines 12-60; fig.2)*

Arnold teaches that “after the interface has provided the application with, for instance, a Uniform Resource Location (URL) of a provider of the requested type of service, the application can cause a more specialized application (such as a Web browser) to be launched which can then use the URL to easily access the provider’s services” (Arnold, col4, lines 19-25). In other words, a command is issued from the second system via an application in order to access or invoke a type of service at the first system. In addition, if the requested service, issued from the second system, was the FTP or SMTP service, and, if available, the second system would possibly invoke these services by issuing the appropriate commands to the first system.

Therefore, the Applicants still failed to clearly disclose the novelty of the invention and identify specific limitation, which would define patentable distinction over prior art.


Art Unit: 2145

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is 571/272-3911. The examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571/272-6159. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9306 for After Final communications.

Thomas Duong (AU2145)

April 15, 2005


VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700